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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------|
| 10/810,526 | 03/27/2004 | Julian James Orbach | 403104-A-01-US (Orbach) | 1176 |
| 47523 7590 04/16/2007 JOHN C. MORAN, ATTORNEY, P.C. 4120 EAST 115 PLACE THORNTON, CO 80233-2623 | | | EXAMINER DOAN, KIET M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2617 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/16/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|-----------------|----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/810,526 | ORBACH, JULIAN JAMES | |
| | Examiner | Art Unit | |
| | Kiet Doan | 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/24/06.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8,10-26,28-30,32-48,50-52 and 54-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8,10-26,28-30,32-48, 50-52 and 54-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Previous Final office action was mailed on 09/08/2006 and is vacated due to the Pre-Brief conference request on file on 01/06/2007. However, the office re-instates Final in this instant office action based on the Remarks and amendment filed on 06/24/2007.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-2, 4, 6-8, 10-24, 26, 28-30, 32-46, 48, 50-52, 54-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over Coombes (Pub. No. 2004/0198461) in view of Burg et al. (Pub. No. 2003/0061354).

Consider **claims 1, 12, 23, 34, 45, 56, 59-60**. Cronin teaches a method for alerting a calling party of a delay before an incoming call will be answered by a user of a called telecommunication terminal, comprising the steps of:

answering the incoming call by the telecommunication terminal in response to an input from the user when the telecommunication terminal is not engaged in another call;

muting an audio path of the answered call from communication with the user (Abstract, Paragraphs [0008], [0011-0012], [0015], Fig. 2, Illustrate and teach incoming call is received by mobile communication device and answering the incoming call by transmits pre-recorded message by input from the user of communication device at the

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same time the call is on hold until means as call is delay before the call can be answer).

Coombes teach the limitation of claim as discuss **but silent on**

receiving a time specifying the delay from the user after the incoming call is received;

inseting the time into a predefined message; and

transmitting the predefined message that is selected by the user to the calling party.

In an analogous art, Burg teaches "Delivery of call queue messages for calls launched from the Internet". Further, Burg teaches receiving a time specifying the delay from the user after the incoming call is received;

inseting the time into a predefined message; and

transmitting the predefined message that is selected by the user to the calling party (Paragraphs [0034], [0080-0081,0088] Burg teach the SCP/SN 140 prepare and up dated status message and transmitting predefined message wherein the message contain specific time of waiting).

Therefore, it would have been obvious at the time that the invention was made that person having ordinary skill in the art to modify Coombes and Burge system, such that answering the incoming call by the telecommunication terminal in response to an input from the user when the telecommunication terminal is not engaged in another call, muting an audio path, receiving a time specifying the delay from the user and transmitting the predefined message that is selected by the user to the calling party to

provide means for the caller awareness of call are still activated and knowing status of call and avoid unnecessary hand up.

Consider **claims 2, 13, 24, 35 and 46**. Coombes teaches the method of claim 1 further comprises the step of maintaining the incoming call from the calling party with the audio path muted to the user; and allowing audio communication by the user with calling party in response to another input from the user (Paragraph [0012] teach call put on hold means as maintaining the incoming call from the calling party and audio/answering normal way by the users).

Consider **claims 4, 15, 26, 37 and 48**. Coombes teaches the method of claim 1 wherein the message is an audio message and the audio message is transmitted via the audio path to the calling party (Paragraph [0011] teach PRGSM as audio message is transmitted to the calling party).

Consider **claims 6, 17, 28, 39 and 50**. Burg teaches the method of claim 5 wherein the step of inserting comprises converting the time to audio information for insertion into the predefined message (Paragraphs [0081], [0088]).

Consider **claims 7, 18, 29, 40 and 51**. Coombes teaches the method of claim 6 further comprises the step of recording the predefined message (Paragraph [0011] teach recording message).

Consider **claims 8, 10, 19, 21, 30, 32, 41, 43, 52, 54, 57-58**. The method of claim 1 wherein the message is a text message (Official notice and well know in the art that text message can be send by telecommunication terminal via text message link).

Consider **claims 11, 22, 33, 44 and 55**. Coombes teaches the method of claim 9 further comprises the step of entering the predefined message (Paragraph [0011]).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 3, 25, 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Moore (Pub. No. 2005/0096023).

Consider **claims 3, 25, 47**. Moore teaches a method for alerting a calling party of a delay before an incoming call will be answered by a user of a called telecommunication terminal, comprising the steps of:

answering the incoming call by the telecommunication terminal in response to an input from the user when the telecommunication terminal is not engaged in another call (Fig.3, step 305 to 320);

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muting an audio path of the answered call from communication with the user (Fig.3, step 325, 330);
transmitting message that is selected by the user to the calling party (Fig.3, step 335); and
terminating the incoming call after transmission of the message (Fig.3, step 335 and end. Which all the imitation is described and teach in paragraphs [0003-0007]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 61-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (Pub. No. 2005/0096023) in view of Burg et al. (Pub. No. 2003/0061354).

Consider **claims 61-63**. Moore teaches the limitations of claim as discuss **but silent on** the method of claim 3 wherein the message is a predefined message and the method further comprises the step of receiving a time specifying the delay before user return the incoming call from the user after the incoming call is received; and
inserting the time into a predefined message.

Burg teaches the method of claim 3 wherein the message is a predefined message and the method further comprises the step of receiving a time specifying the

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delay before user return the incoming call from the user after the incoming call is received; and

inserting the time into a predefined message (Paragraphs [0080-0081,0088]).

Therefore, it would have been obvious at the time that the invention was made that person having ordinary skill in the art to modify Moor and Burge system, such that a time specifying the delay before user return the incoming call from the user after the incoming call is received; and inserting the time into a predefined message to provide means for the users know how long that he/she have to wait or on hold in order to save time and convenient.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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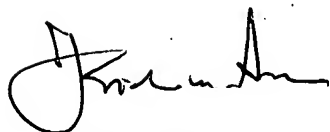
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiet Doan whose telephone number is 571-272-7863.

The examiner can normally be reached on 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kiet Doan
Patent Examiner


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER